

01-28-02

A

Practitioner's Docket No. 700953-047113-C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jeffrey Schlom; Judith Kantor; Donald Kufe; Dennis Panicali, and Linda Gritz  
Application No.: To be assigned (Con't of 09/366,670) Group No.: To be assigned  
Filed: To be assigned (August 3, 1999) Examiner: To be assigned  
For: RECOMBINANT POX VIRUS FOR IMMUNIZATION AGAINST MUC1  
TUMOR-ASSOCIATED ANTIGEN

CERTIFICATE OF MAILING

I hereby certify that this correspondence, on the date shown below, is being deposited with the United States Postal Service with sufficient postage as Express Mail Label No. EL565093478US in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231.

Date: January 25, 2002

Michelle M. Gignac

Box Patent Application  
Assistant Commissioner for Patents  
Washington, D.C. 20231

NEW APPLICATION TRANSMITTAL

1. Type of Application

This transmittal is for a continuation application.

2. Benefit of Prior U.S. Applications (35 U.S.C. Sections 119(e), 120, or 121)

The new application being transmitted claims the benefit of prior U.S. applications. Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATIONS CLAIMED.

3. Papers Enclosed

A. Required for filing date under 37 C.F.R. 1.53(b) (Regular) or 37 C.F.R. 1.153 (Design) Application

41 Pages of Specification  
3 Pages of Claims  
5 Sheets of Drawings

B. Other Papers Enclosed

1 Page of abstract

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**4. Additional Papers Enclosed**

1. Preliminary Amendment
2. Information Disclosure Statement (37 C.F.R. 1.98)
3. Form PTO-1449 (PTO/SB/08A and 08B)
4. Sequence Listing Transfer

**5. COPY of Declarations or Oaths**

Enclosed and executed by Jeffrey Schlom; Judith Kantor; Donald Kufe; Dennis Panicali, and Linda Gritz.

**6. Language**

English

**7. Assignment**

Assignments of the invention have been recorded as follows:

1. Assignee: Therion Biologics Corporation  
Assignors: Dennis Panicali and Linda Dr. Linda Gritz  
Recordation Date: 12/27/1999  
Reel/Frame: 010462/0226
2. Assignee: Dana-Farber Cancer Institute  
Assignors: Donald Kufe  
Recordation Date: 12/27/1999  
Reel/Frame: 010462/0215
3. Assignee: Department of Health and Human Services, United States of America, The  
National Institutes of Health  
Assignors: Judith Kantor and Jeffrey Schlom  
Recordation Date: 12/09/1999  
Reel/Frame: 010894/0927

**7. Petition for Extension of Time**

Attached please find a copy of a Petition for a 2-month extension which is being filed concurrently in the USPTO under separate cover.

10057136 012502

In re application of: Jeffrey Schlom; Judith Kantor; Donald Kufe; Dennis Panicali, and Linda Gritz  
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**8. Fee Calculation (37 C.F.R. Section 1.16)**

|                     |              |                              |
|---------------------|--------------|------------------------------|
| Regular Application | Small Entity | Other Than A<br>Small Entity |
|                     | \$370.00     | \$740.00                     |
| Basic Fee: \$740.00 |              |                              |

| <u>Claims</u>                                 | Present<br><u>Extra</u> | <u>Rate</u> | Addit.<br><u>Fee</u> | <u>OR</u> | Other Than A<br><u>Small Entity</u> | Addit.<br><u>Fee</u> |
|---|-------------------------|-------------|----------------------|-----------|-------------------------------------|----------------------|
| Total: 20                                     | Minus 20                | = 0         | x \$9 =              |           | x \$18 =                            | \$ 00.00             |
| Indep.: 4                                     | Minus 3                 | = 1         | x \$42 =             |           | x \$84 =                            | \$ 84.00             |
| [ ] 1st Presentation Multiple Dependent Claim |                         |             | + \$140              |           | +280 =                              | \$ 00.00             |
|   | Total                   |             |                      |           | Total                               |                      |
|   | Addit. Fee = \$         |             |                      | <u>OR</u> | Addit. Fee = \$                     | 84.00                |

Total Filing Fee: \$ 824.00

\* Please note that claim 1 remains in the initial filing and is included in the payment of fees and that a subsequent preliminary amendment is enclosed canceling claim 1.

**9. Fee Payment Being Made at This Time**

Enclosed

Filing Fee \$ 824.00

**Total Fees Enclosed** \$ 824.00

**10. Method of Payment of Fees**

Check in the amount of \$ 824.00 is attached.

**11. Instructions as to Deficiencies/Overpayment**

Please charge any deficiencies or credit any overpayments to Deposit Account No. 50-0850.

10057136-012502

In re application of: Jeffrey Schlom; Judith Kantor; Donald Kufe; Dennis Panicali, and Linda Gritz  
Application No.: To be assigned (Con't of 09/366,670) Group No.: To be assigned  
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**12. Relate Back**

**\*Preliminary Amendment enclosed.**


**A. 35 U.S.C. Section 119(e)**

Amend the specification by inserting, before the first line, the following sentence:

"The following application is a continuation of U.S. Serial No. 09/366,670 filed on August 3, 1999, which is a continuation of PCT/US98/03693 filed on February 24, 1998, now abandoned, which claimed benefit under 35 U.S.C. §119 of U.S. Provisional Application 60/038,254 filed on February 24, 1997."

Date: 1/25/02

Customer No. 26770

  
\_\_\_\_\_  
David S. Resnick (Reg. No. 34,235)  
Lana A. Shvartsman (Reg. No. 48,502)  
NIXON PEABODY LLP  
101 Federal Street  
Boston, MA 02110  
Tel. (617) 345-6057

10057136-012502

In re application of: Jeffrey Schlom; [REDACTED] Kantor; Donald Kufe; Dennis Panicali; and Linda Gritz  
Application No.: To be assigned (Class of 09/366,670) Group No.: To be assigned  
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### REMARKS

In accordance with the provisions of 37 C.F.R. §1.97, this statement is being filed:

- X   (1) within three (3) months of the Filing Date or **before the mailing date of the First Office Action** on the merits; or
- (2) within three months of the mailing date of the PCT International Search Report; or
- (3) after the period defined in (1) but before the mailing date of a **Final Rejection or Notice of Allowance**, and the requisite Certification or fee under Rule 1.17(p), namely **\$180.00**, is included herein; or
- (4) after the mailing date of a **Final Rejection or Notice of Allowance** but before the payment of the **Issue Fee**, and the requisite Certification, petition, and petition fee are included herein.

It is respectfully requested that each of the documents shown on the attached Forms PTO/SB/08A and PTO/SB/08B be made of record in this application. Copies of these documents (CHECK ONE):

- are enclosed herewith; or
- X   have been cited in the parent application, and are thus not being resubmitted herein.

10057136.012502

In re application of: Jeffrey Schlom; [REDACTED] Kantor; Donald Kufe; Dennis Panicali; and Linda Gritz  
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Filed: To be assigned (August 3, 1999) Examiner: To be assigned  
For: RECOMBINANT POX VIRUS FOR IMMUNIZATION AGAINST MUC1 TUMOR-ASSOCIATED ANTIGEN

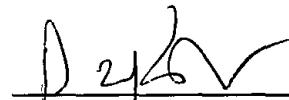
### FEE AUTHORIZATION

Should any fees associated with the submission be required, the Commissioner is authorized to charge the missing fee to our Deposit Account No. 50-0850. Any overpayments should be credited to said Deposit Account.

Date: January 25, 2002

Customer No.: 26770

Respectfully submitted,

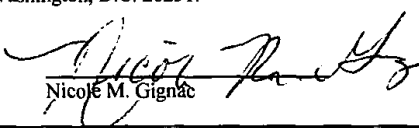


David S. Resnick (Reg. No. 34,235)  
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10057136, 012502

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| CERTIFICATE OF MAILING  |  |
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| Date: January 25, 2002  | <br>Nicole M. Gignac |

Box Patent Application  
Assistant Commissioner for Patents  
Washington, D.C. 20231

EXPRESS MAIL CERTIFICATE

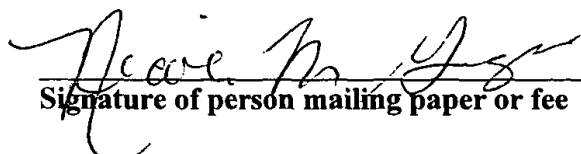
"Express Mail" label number: EL565093478US  
Date of Deposit: January 25, 2002

I hereby state that the following *attached* papers and fees:

1. New Application Transmittal – Continuation Application (4 pp.);
2. Copy - Petition for Extension of Time (1 pg.);
3. Continuation Application (49 pp.): Spec. 41 pp.; Claims 3 pp.; Drawings 5 pp. and Abstract 1pg.;
4. Preliminary Amendment with Version to Show Marked Changes (8 pp.);
5. COPY – Declarations executed by J. Schlom, J. Kantor, D. Kufe, D. Panicali and L. Gritz (15 pp.);
6. Transfer of Sequence Listing (1 pg.);
7. Information Disclosure Statement (3 pp.);
8. PTO/SB/08A (1 pg.);
9. PTO/SB/08B (1 pg.);
10. Check - \$824.00;
11. Return Receipt Postcard;

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. section 1.10, on the date indicated above and is addressed to Box Patent Application, Assistant Commissioner for Patents, Washington, D.C. 20231.

Nicole M. Gignac

  
Signature of person mailing paper or fee

# COPY

Practitioner's Docket No. 700953-047113-C2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jeffrey Schlom; Judith Kantor; Donald Kufe; Dennis Panicali; and Linda Gritz  
Application No.: 09/366,670 Group No.: 1632  
Filed: August 3, 1999 Examiner: R. Shukla  
For: RECOMBINANT POX VIRUS FOR IMMUNIZATION AGAINST MUC1  
TUMOR-ASSOCIATED ANTIGEN

JCE979 U.S. PRO  
10/057136  
01/25/02

Box Patent Application  
Assistant Commissioner for Patents  
Washington, D.C. 20231

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a) and 1.10)

I hereby certify that this correspondence:

1. Petition for Extension of Time – 2-months (1 pg.);
2. Duplicate Copy - Petition for Extension of Time – 2-months (1 pg.);
3. Return Receipt Postcard;

is on the date shown below being:

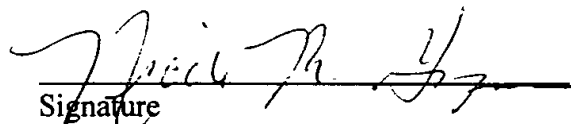
MAILING

☒ deposited with the United States Postal Service  
and with sufficient postage as first class mail in an  
envelope addressed to the Assistant Commissioner  
for Patents, Washington, D.C. 20231.

FACSIMILE

transmitted by facsimile to the Patent  
Trademark Office.

Date: January 25, 2002

  
Signature

Nicole M. Gignac  
(type or print name of person certifying)